

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

The present response corrects the error noted in the Notice of Non-Compliant Amendment dated April 22, 2008. Claim 7 is now correctly labeled “Previously Presented.”

Claims 1-3 and 5-13 are presently pending in this case. New Claims 12 and 13 are added by the present amendment. As new Claims 12 and 13 are supported by the original disclosure,¹ no new matter is added.

In the outstanding Official Action, Claims 1, 2, 5, 7, 8, and 10 were rejected under 35 U.S.C. §102(b) as unpatentable over Fleck et al. (U.S. Patent No. 6,977,811, hereinafter “Fleck”) in view of Goodman et al. (U.S. Patent No. 6,100,875, hereinafter “Goodman”) and further in view of Harada et al. (U.S. Patent No. 6,072,476, hereinafter “Harada”) ; Claims 3 and 9 were rejected 35 U.S.C. §103(a) as unpatentable over Fleck in view of Goodman and Harada and further in view of Boehme et al. (U.S. Patent No. 6,512,670, hereinafter “Boehme”); and Claims 6 and 11 were rejected 35 U.S.C. §103(a) as unpatentable over Fleck in view of Goodman and Harada and further in view of Bhatia (U.S. Patent No. 6,288,895).

Applicants and Applicants’ representatives thank Supervisory Patent Examiner Lefkowitz and Examiner Amadiz for the courtesy of the interview granted to Applicants’ representatives on March 28, 2008. During the interview, differences between the claims and the cited references were discussed. Examiner Amadiz agreed to reconsider the rejections of record after submission of the present response.

With regard to the rejection of Claims 1 and 7 as unpatentable over Fleck in view of Goodman and further in view of Harada, that rejection is respectfully traversed.

Claim 1 recites in part:

¹See, e.g., Figure 4.

a display;
a main unit provided with a keyboard having a plurality of operation keys including an enter key;
a pointing device configured to move a pointer appearing on the display in a desired direction;
a plurality of cursor keys configured to move a cursor appearing on the display in predetermined directions, the cursor keys being arranged near the pointing device;
a confirmation button configured to confirm an item selected by said pointing device or said cursor keys, the confirmation button being positioned near said cursor keys; and
a switching button configured to rotate a display screen of said display by 90°,
wherein said pointing device, said plurality of cursor keys, and said confirmation button are positioned between said display and said keyboard.

Fleck describes a keyboard with a mouse for handheld portable computer. The outstanding Office Action cited mouse button 300 of Fleck as “a pointing device” and arrow buttons 302-308 of Fleck as “cursor keys.” However, as noted in the Office Action, arrow keys 302-308 do not move a cursor, and cursor movement keys 110-116 of Goodman recited for this feature. However, arrow buttons 302-308 of Fleck move a displayed page while a cursor is fixed on the screen. This allows access to a large page that is being displayed on a small display. As Fleck describes at column 3, lines 18-28, this is only efficient when the arrow buttons are located around the mouse button.

Thus, the proposed modification, replacing the arrow keys 302-308 of Fleck with cursor movement keys 110-116 of Goodman would make the device of Fleck unsuitable for its intended purpose. As described in MPEP §2143.01, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case, without arrow buttons 302-308, the device of Fleck cannot scroll across a page so that a user can eventually see the entire page on the small display. Therefore, the miniaturized device of Fleck needs arrow buttons 302-308 to access the entire screen. By replacing these arrow buttons with additional buttons for

moving the cursor, the proposed combination makes the device of Fleck unsuitable for its intended purpose, which is to provide a compact device with an efficient way of displaying and selecting information. Accordingly, there can be no suggestion or motivation to combine Fleck and Goodman as proposed. Consequently, Claim 1 (and Claims 2, 3, 5, 6, 12, and 13 dependent therefrom) is patentable over the cited references.

In a similar manner, Claim 7 (and Claims 8-11 dependent therefrom) is also patentable over the cited references, as there is no suggestion motivation to combine Fleck and Goodman as proposed.

With regard to the rejection of Claims 3 and 9 as unpatentable over Fleck in view of Goodman and Harada and further in view of Boehme, it is noted that Claims 3 and 9 are dependent from Claims 1 and 7, respectively, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Boehme does not cure any of the above-noted deficiencies of Fleck, Goodman, and Harada. Accordingly, it is respectfully submitted that Claims 3 and 9 are patentable over Fleck in view of Goodman and Harada and further in view of Boehme.

With regard to the rejection of Claims 6 and 11 as unpatentable over Fleck in view of Goodman and Harada and further in view of Bhatia, it is noted that Claims 6 and 11 are dependent from Claims 1 and 7, respectively, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Bhatia does not cure any of the above-noted deficiencies of Fleck, Goodman, and Harada. Accordingly, it is respectfully submitted that Claims 6 and 11 are patentable over Fleck in view of Goodman and Harada and further in view of Bhatia.

New Claims 12 and 13 are supported at least by Figure 4. New Claims 12 and 13 are dependent from Claim 1, and thus are patentable for at least the reasons described above. Further, new Claims 12 and 13 recite subject matter that further defines over the cited

references. For example, new Claim 12 recites “said plurality of cursor keys are arranged around a periphery of the pointing device such that the pointing device is at the center of the cursor keys, and said confirmation key is arranged at a periphery of the cursor keys.” In contrast, the mouse button 300 of Fleck, the cursor movement keys 110-116 of Goodman, and the rotation button 65 of Harada are not arranged as recited in new Claim 12.

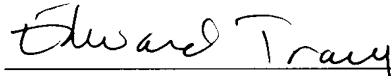
Accordingly, new Claim 12 (and new Claim 13 dependent therefrom) further defines over the cited references.

Accordingly, the pending claims are believed to be in condition for formal allowance.

An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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